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Attorney Docket No. 4031/1 - 15719US00

REMARKS

The present application includes claims 16-20, 22, and 103. Claims 16-20, 22, and 103 were rejected. By this Amendment, claim 21 has been canceled, claims 16-19 have been amended, and new claims 104-121 have been added.

I.   The Rejection Of Claims 16-20, 22, and 103 As Being Indefinite

Claims 16-20, 22, and 103 were rejected under 35 U.S.C. § 112, second paragraph as indefinite for failing to particularly point out and distinctly claim the subject matter of the invention.

One of the aspects of claim 16 that was brought to the attention of the Applicant was the nature of the antecedent basis for "the protocol characteristic" in lines 5 and 9. Claim 16 has been amended to clarify the antecedent basis.

Further, the Office Action has identified all of claim 16 as indefinite, but the Applicant is not complete certain as to which aspects of claim 16 were found to be unclear. Nonetheless, the Applicant has made significant amendments to claim 16 in an effort to clarify claim 16 for the Examiner. The Applicant is willing to work with the Examiner and stands ready to make further clarifying amendments if required by the Examiner, although in the event that further amendments are desired by the Examiner, the Applicant requests that such amendments be identified more specifically.

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II. The Rejection Of Claims 16 And 22 As Being Unpatentable Over Auerbach In View Of Kim

The Applicant now turns to the rejection of claims 16 and 22 under 35 U.S.C. §

103(a) as being unpatentable over Auerbach, U.S. Patent No. 6,549,937 in view of Kim,

U.S. Patent No. 6,490,274. In order for a *prima facie* case of obviousness to be established,

the MPEP states the following:

> First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art.

See MPEP § 2142. Additionally, if a *prima facie* case of obviousness is not established,

the Applicant is under no obligation to submit evidence of nonobviousness.

> The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See Id.

A. The Client/Server Architecture Shown In Auerbach And The Peer-To-Peer Architecture Shown In Kim Are Mutually Exclusive.

Two distinct and separate types of communications systems are a shown in the

cited art: a client/server architecture and a peer-to-peer architecture. In a

communications system, information may be passed between participants using either a

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client/server architecture or a peer-to-peer architecture, but not both. That is, communications may be either routed directly between peers (as in a peer-to-peer network) or may be directed to a server (as in a client/server network), but not both. Thus, if a network communicates directly between peers without communicating with a server, then the architecture is a peer-to-peer architecture. Conversely, if the architecture does not support direct communication between peers and instead routes communications between peers to a server, then the architecture is a client/server architecture.

Furthermore, the focus of a peer-to-peer network is to avoid interaction with a server, which is the heart of a client/server architecture. A peer-to-peer network is specifically designed to NOT be implemented in a client/server architecture. Consequently, a client/server architecture and a peer-to-peer architecture are mutually exclusive.

B.   The Client/Server Architecture Of Auerbach Is Not Combinable With The Peer-To-Peer Network Of Kim.

Auerbach teaches a client/server architecture. That is, Auerbach shows, at Figures 2-3, an instant messaging system that uses <u>client/server</u> architecture. The purpose of Auerbach is explicit: "The present invention provides a universal <u>client</u> application and an underlying conversion platform that allows the <u>client</u> application to communicate with the <u>servers</u> of multiple service providers." Auerbach at column 4, lines 51-54. In addition to communicating with servers, Auerbach's invention exploits various features of the servers associated with Internet service providers. For example,

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Auerbach's "system 100 utilizes the contact list storage techniques implemented by each service provider rather than creating and storing a universal contact list." Auerbach, at column 5, lines 62-65.

Further, Auerbach discloses a client/server configuration for proper operation. For instance, according to Figure 2 and column 5, lines 10-20, Auerbach's system is designed to operate with various service providers, each of which has its own proprietary server. Auerbach's scheme is dependent on the servers. For example, according to column 13, lines 5-8 Auerbach states that "communication may be terminated unexpectedly, such as a failure of a server . . . ." Additionally, Auerbach's communication requires that all messages be directed to and from servers as described from column 7, line 65 through column 8, line 38. At column 8, lines 16-18 Auerbach states, "the SP1 Protocol services module 130 transmits the message to the SP1 server 106." Reading further to column 8, lines 20-22, it states "the message intended for the user of the client 102 is transmitted from the SP1 server 106 to the client . . . ." Moreover, Auerbach piggybacks off of service providers' servers to provide certain features, such as the maintenance of contact lists. For example, Auerbach relies on data stored remotely by the service providers for the provision of presence data and contact lists. At column 11, lines 49-51 Auerbach states, "The presence data is provided by each service provider server and relayed to the UI 116 . . . ."

In contrast, Kim teaches a peer-to-peer architecture. That is, Kim shows, at Figures 2-4, a way to create a peer-to-peer connection between IP-ready telephones. For

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example, "[I]f it is determined in step 304 that there is an IP address, peer-to-peer IP telephony is set between the first or second cable phone 208 or 214 and the third or fourth cable phone 246 or 248 (step 306) to connect a call (step 310)." Kim at column 4, lines 61-65.

As shown above, the client/server architecture is fundamental to Auerbach. Consequently, Auerbach can not be implemented in an architecture other than a client/server architecture, such as the peer-to-peer network of Kim. Consequently, it is respectfully submitted that Auerbach and Kim have not been shown by the Examiner to be combinable.

Further, when a claim is rejected, 35 U.S.C. § 132 requires that the Applicant be provided with "such information and references as may be useful" in continuing the prosecution of the patent application. Consequently, pursuant to 35 U.S.C. § 132, the Applicant respectfully traverses and requests a more detailed explanation and the information and references that the Examiner is relying on to establish that the peer-to-peer network of Kim is combinable with the client/server network of Auerbach.

C.   Even If It Were Possible To Combine The Client/Server Architecture Of Auerbach With The Peer-To-Peer Network Of Kim, Such A Combination Would Be An Impermissible Change In The Operation Of Auerbach And/Or Kim.

It is well-established that a proposed modification of references cannot change the principle of operation of a reference. MPEP § 2143.01. Nor may a proposed modification render the prior art unsatisfactory for its intended purpose. A rejection

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based on obviousness is not sufficient when the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in the primary reference as well as a change in the basic principle under which the primary reference construction was designed to operate." MPEP § 2143.01

Auerbach is a client/server architecture. Kim is a peer-to-peer network. Any attempt to cobble a client/server architecture as shown in Auerbach into a peer-to-peer architecture as shown in Kim would constitute an impermissible change in the operation of either the client/server architecture, the peer-to-peer architecture, or more likely both. For example, directing communications to a centralized server instead of a peer in a peer-to-peer network like Kim would impermissibly change the peer-to-peer architecture to a client/server architecture.

Thus, the proposed combination of a peer-to-peer network and a client/server network represents "the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed.Cir. 1983). Consequently, it is respectfully submitted that Auerbach and Kim are not combinable and that the present rejection should be withdrawn.

Further, when a claim is rejected, 35 U.S.C. § 132 requires that the Applicant be provided with "such information and references as may be useful" in continuing the prosecution of the patent application. Consequently, pursuant to 35 U.S.C. § 132, the Applicant respectfully traverses and requests a more detailed explanation and the

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information and references that the Examiner is relying on to establish that combining the

peer-to-peer network of Kim with the client/server network of Auerbach would not

constitute an impermissible change in the operation of Auerbach and/or Kim.

**D.   Even If It Were Possible To Combine The Client/Server Architecture
of Auerbach With The Peer-to-peer Network Of Kim, The Use Of A
Peer-To-Peer Architecture Teaches Away From The Use Of A
Client/Server Architecture.**

As discussed above, a peer-to-peer network is specifically designed to exclude

interaction with the centralized server that is at the heart of a client/server architecture.

The design of a peer-to-peer network as a whole is a teaching away from a client/server

architecture. Consequently, there can be no motivation to combine Auerbach and Kim

because the peer-to-peer network of Kim teaches away from the use of a centralized

server that is the heart of Auerbach.

It is impermissible to pick and choose single isolated elements from Auerbach and

Kim while ignoring the limitations of the reference as a whole. "A prior art reference

must be considered in its entirety, i.e., as a whole, including portions that would lead

away from the claimed invention." MPEP at § 2141.02. The Applicant respectfully

submits that it is impermissible to pick and choose elements from Auerbach and Kim

when the peer-to-peer network of Kim teaches away from the client/server network of

Auerbach.

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Thus, the peer-to-peer architecture of Kim teaches away from the client/server architecture of Auerbach. Consequently, it is respectfully submitted that Auerbach and Kim are not combinable and that the present rejection should be withdrawn.

Further, when a claim is rejected, 35 U.S.C. § 132 requires that the Applicant be provided with "such information and references as may be useful" in continuing the prosecution of the patent application. Consequently, pursuant to 35 U.S.C. § 132, the Applicant respectfully traverses and requests a more detailed explanation and the information and references that the Examiner is relying on to establish that the use of the peer-to-peer network of Kim does not teach away from the use of the client/server network of Auerbach, and vice versa.

E.   **Even If It Were Possible To Combine The Client/Server Architecture Of Auerbach With The Peer-To-Peer Architecture Of Kim, There Is No Motivation In The References To Combine The Peer-To-Peer Architecture Of Kim With The Client/Server Architecture Of Auerbach.**

In order to combine the references, the motivation to combine must come from the references themselves or the knowledge of one of ordinary skill in the art. However, even absent the teaching away of the peer-to-peer network, there is no motivation to combine the peer-to-peer network of Kim with the client/server network of Auerbach.

The specification of Auerbach makes it clear that Auerbach relies on relaying messages through a centralized server and consequently is not a peer-to-peer network. Further, there is no teaching of motivation in Auerbach to combine the client/server

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architecture of Auerbach with a peer-to-peer network (even if such were possible).

Similarly, Kim teaches a peer-to-peer network that does not rely on a centralized server.

There is no teaching or motivation in Kim to combine the peer-to-peer network of Kim

with a client/server architecture. The peer-to-peer network as shown my Kim and the

client/server architecture as shown by Auerbach are simply mutually exclusive types of

networks and no motivation to combine a peer-to-peer network with a client/server

network is shown in Auerbach or Kim.

Additionally, as mentioned above, the peer-to-peer network of Kim and the

client/server network of Auerbach are mutually exclusive. Consequently, one of ordinary

skill in the art would be able to choose either the peer-to-peer network of Kim or the

client/server network of Auerbach, but not both. Thus, because the peer-to-peer network

of Kim and the client/server network of Auerbach are not combinable, the person of

ordinary skill in the art could not have any motivation to combine them.

Consequently, none of Auerbach, Kim, or the knowledge of one of ordinary skill

in the art provide the motivation to combine the peer-to-peer network and the

client/server network. Consequently, it is respectfully submitted that Auerbach and Kim

are not combinable and that the present rejection should be withdrawn.

Further, when a claim is rejected, 35 U.S.C. § 132 requires that the

Applicant be provided with "such information and references as may be useful" in

continuing the prosecution of the patent application. Consequently, pursuant to 35

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explanation and the information and references that the Examiner is relying on to

establish the motivation to combine the peer-to-peer network of Kim with the

client/server network of Auerbach.

III.   The Rejection Of Claims 17-20, and 103 As Being Unpatentable Over Auerbach In View Of Appelman

The Applicant turns now to the rejection of claims 17-20, and 103 under 35

U.S.C. § 103(a) as being unpatentable over Auerbach, in view Appelman, U.S. Patent

No. 6,750,881. Claims 17-20 and 103 depend from independent claim 16. As discussed

above, independent claim 16 is now believed to be allowance. Consequently, claims 17-

20 and 103 are also respectfully submitted to be allowable.

IV.   New Claims

New claims 104 to 121 have been added. New claims 104 to 121 include

independent claims 108, 112-114, and 118. As discussed further below, the above-

mentioned distinctions over the cited art also apply to the new claims.

New claim 108 is similar to claim 16, but adds the additional limitation of

encrypting communications in the instant messaging session.

New claims 112 and 113 are similar to claim 16, but more clearly recite the

structural elements set forth in the preamble of claim 16. Claims 112 and 113 are

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alternatives to claim 16 that are offered to assist the Examiner in determining clarity in light of the previous rejection under 112, second paragraph. Further, although claim 112 and 113 are highly similar, they differ in their last step. Specifically, claim 112 is directed toward establishing a connection between users and claim 113 is directed toward displaying an instant message.

New claims 114 and 118 are similar to claim 16 (and 112 and 113) and are additionally alternatives to claim 16. Further, although claim 114 and 118 are highly similar, claim 114 is a system claim and claim 118 is a method claim.

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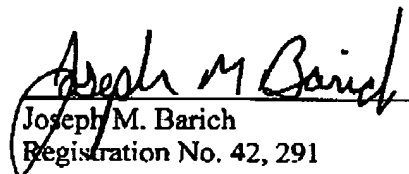Attorney Docket No. 4031/1 - 15719US00

CONCLUSION

In light of the above, it is respectfully submitted that the pending claims are allowable over the cited art. If the amendments and remarks above are believed to be insufficient for allowance, a personal interview is respectfully requested to advance the prosecution of the patent application.

If the Examiner has any questions or the Applicant can be of any assistance, the Examiner is invited and encouraged to contact the Applicant at the number below.

The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

Date: _____July 25, 2005_____

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